

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of:
Jacqueline Eynne Breuninger Buskop**

Group Art Unit: 3677

Serial Number: 10/675,515

Examiner: Reese, David C

Filed: 09/30/2003

Confirmation Number: 6098

**For: ADVERTISING DEVICE FOR
PRODUCE AND CANDY VENDORS**

Attorney Docket Number: 1207.01A

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S AMENDED BRIEF ON APPEAL

Sir:

This amended brief is in furtherance of the Notice of Appeal filed in this case on August 8, 2006 and is submitted in further response to the Notice of Non-Compliant Appeal Brief mailed November 1, 2006.

If an extension of time is required to enable this paper to be timely filed and there is no separate Petition for Extension of Time filed herewith, this paper is to be construed as also constituting a Petition for Extension of Time under 37 CFR § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

The Commissioner is authorized to deduct the fee for filling this Appeal Brief

(\$250) from **Buskop Law Group P.C., Deposit Account No. 50-1313**. No other fee is believed to be due in connection with the filing of this document. However, should any fee under 37 CFR § 1.16 to 1.21 be deemed necessary for any other reason relating to this document, the Commissioner is hereby authorized to deduct said fee from **Buskop Law Group Deposit P.C., Account No. 50-1313**.

I. REAL PARTY IN INTEREST

The present application is owned by Jacqueline Evynne Breuninger Buskop.

II. RELATED APPEALS AND INTERFERENCES

Appellant are not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF CLAIMS

Claims 1-2, 4-10, and 12-14 remain pending in this application. Claims 1-2, 4-10, and 12-14 are rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 5,201,578 (hereinafter *Westmoland*) in view of case law. Claims 3 and 11 have been cancelled.

The claims currently under consideration, ie, Claims 1-2, 4-10, and 12-14 are listed in the Claims Appendix.

IV. STATUS OF AMENDMENTS

There was an amendment filed on February 3, 2006 to address the informalities made by the Office Action dated November 29, 2005. Applicant believe that the Claims as presented in the February 3, 2006 Response Amendments to the Office Action are in proper form for allowance.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Generally, and as described below, one or more embodiments of the claimed invention, Claim 1 and 8, are directed to an advertising device for produce vendors or candy vendors comprising: at least one earring clip with a back side and front side for engaging a non-pierced ear; at least one hook secured to the earring clip; at least one edible food item such as candy, fruit a vegetable, or combinations of these items which can be pierced by the hook and removably secured to the hook.

Figure 1 illustrates a front view of the apparatus secured to an ear with two blueberries attached. Applicant's Application, p. 2, lines 17-22. In the illustrated embodiment, the apparatus has an earring clip (10) for engaging a non-pierced ear (100). *Id.* One hook (12) is secured to the earring clip (10) and one edible food item (14) or two edible food items (14a) can be removable secured to the hook (12). *Id.*

The apparatus is contemplated for the use and display of edible food items that have skins that can be pierced with a hook, but still maintain their shape. Applicant's Application, p. 3, lines 15-18. The edible food items can include candy. Applicant's Application, p. 23, lines 19-22.

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1-2, 4-10, and 12-14 are patentable over US Patent No., 5,201,578 (hereinafter *Westmoland*) in view of case law.
2. Whether Claims 1 and 8 are properly objectionable.

VII. ARGUMENT

The rejected Claims 1-2, 4-10, and 12-14 in view of *Westmoland* in further view of case law are allowable for several reasons.

THE OFFICE ACTION FAILS TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS AGAINST CLAIM 1 AND 8

Examiner proposed in the Office Action dated April 4, 2006 an “obviousness” assertion that jewelers would have been aware of the ancillary, corollary, and atypical use of “food items” such as their application as the one proposed by the Examiner. This is contrary to *In re Dembiczak* 175 F.3d 994, 30 USPQ2d 1614 (Fed. Cir. 1999). In *In re Dembiczak*, the Court reversed a 35 USC § 103 rejection based on “the relationship between the fields of conventional trash bags and children’s crafts, respectively (“[t]he artisan would also have been aware of the ancillary, corollary, and atypical uses of ‘trash’ bags such as their application in hobby and art projects”).

Applicant believes that no such relationship has been demonstrated. Since the Office Action cited no other references to support this “obviousness” assertion, the Applicant is forced to infer that the Examiner had made this assertion based on personal knowledge. No supporting affidavit has been made of record. According to 37 CFR § 1.104(d)(2),

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other personals.

The Examiner has failed to provide any substantiating prior art or any affidavit in accordance with 37 CFR § 1.104(d)(2) in relating that jewelers would have been aware of the ancillary, corollary, and atypical use of “food items”. The Applicant submits that this fact alone sufficiently establishes that the Examiner has failed in his proof of making a prima facie case of obviousness. Accordingly, the claims are allowable for this reason alone.

THE OFFICE ACTION FAILS TO PROVIDE THE BROADEST
REASONABLE INTERPRETATION OF CLAIM 1

Generally, as noted above, one or more of the embodiments of the present invention are directed towards an advertising device for produce vendors or candy vendors comprising: at least one earring clip with a back side and front side for engaging a non-pierced ear; at least one hook secured to the earring clip; at least one edible food item such as candy, fruit, a vegetable, or combinations of these items which can be pierced by the hook and removably secured to the hook.

Against this general backdrop, Claim 1, which is representative of Claims 2, and 4-7 is discussed. Claim 1 calls for an advertising apparatus for produce vendors with at least one earring clip, a hook secured to the earring clip, and one edible food item removable secured to the hook. The claim further calls for an automatic LED disposed onto the clip for lighting the edible food item.

The Examiner asserts that Claim 1 is unpatentable over *Westmoland* in view of case law under section 103. *Westmoland* is directed to an article of jewelry having a body with two plate members which sandwich a battery between them and have lighted elements electrically connected between the plate members to be illuminated by the battery. *Westmoland* Abstract. *In re Said*, as applied by the Examiner is used to distinguish that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentable distinguish the claimed invention from the prior art. *See* Office Action April 4, 2006.

The Examiner's approach to construing the claims is inconsistent with the well established principles of claim construction. The Examiner relates that, with respect to the "edible food items" they are matters relating to ornamentation only. The Examiner's position is legally improper, as it eviscerates the broadness requirement enunciated by the Federal Circuit. *See* DeGeorge v. Bernier, 768 F.2d 1318 (Fed. Cir. 1985) ("Claims during prosecution...are given the broadest reasonable interpretation possible"). Based upon Federal Circuit precedent Applicant's edible food items should not be construed as ornamentation only. Edible food items of Applicant's Application should be given the broadest reasonable interpretation and in doing so refer to Applicant's specification for their interpretation.

Applicant's Application refers to "edible food items" as "blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, and other fruits and vegetables with similar sturdy yet pierce-able skins". Applicant's Application page 3, lines 17-18. Applicant choice of "edible food items" is not based upon its aesthetic appeal for ornamentation instead they are based off their durability and ability to stay upon the hook. In doing so the typical user of Applicant's invention, produce vendors, would be able to display and advertise those "edible food items" in which they want to.

THE REFERENCES AS CITED IN THE OFFICE ACTION FAILS TO DISCLOSE CLAIMED FEATURES OF APPLICANT'S APPLICATION OF CLAIM 1

Notwithstanding the Examiner's failure to comply with Federal Circuit precedent, *Westmoland* fails to disclose the claimed features, even under Examiner's construction of the claim terms. The first element of Claim 1 in Applicant's Application calls for an earring clip wherein one hook is secured onto the clip and a food item is secured to the hook. An automatic LED is additionally disposed on the clip for lighting the food item.

In *Westmoland*, even assuming that "edible food items" are chosen solely for their aesthetic appeal for ornamentation, Applicant's "edible food items" are hung from the earring clip not from the lighting element as in *Westmoland*. In *Westmoland*, the pierced earring wire (10a) is attached to an lighting element (4a) whereby decorative elements (29) may be hung from. *Westmoland* Figure 8, Column 6 line 37 – Column 7 line 15. Applicant's Application, as demonstrated in Figure 2, attaches an LED light (16) secured to an earring clip (10). The earring clip (10) additionally has hooks (12) and (15) wherein the edible food items are to be hung by. Applicant's Application page 3 line 1 – line 10, Figure 2.

THE OFFICE ACTION FAILS TO PROVIDE THE BROADEST REASONABLE INTERPRETATION OF CLAIM 8

Claim 8, which is representative of Claims 9-10 and 12-14 is discussed. Claim 8 calls for an advertising apparatus for candy vendors with at least one earring clip, a hook secured to the earring clip, and one chewy candy item removably secured to the hook. The claim further calls for an automatic LED disposed onto the clip for lighting the chewy candy item.

The Examiner asserts that Claim 8 is unpatentable over *Westmoland* in view of case law under section 103. *Westmoland* is directed to an article of jewelry having a body with two plate members which sandwich a battery between them and have lighted elements electrically connected between the plate members to be illuminated by the battery. *Westmoland* Abstract. *In re Said*, as applied by the Examiner is used to distinguish that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentable distinguish the claimed invention from the prior art. *See* Office Action April 4, 2006.

The Examiner's approach to construing the claims is inconsistent with the well established principles of claim construction. The Examiner relates that, with respect to the "chewy candy items" they are matters relating to ornamentation only. The Examiner's position is legally improper, as it eviscerates the broadness requirement enunciated by the Federal Circuit. *See* DeGeorge v. Bernier, 768 F.2d 1318 (Fed. Cir. 1985) ("Claims during prosecution...are given the broadest reasonable interpretation possible"). Based upon Federal Circuit precedent Applicant's chewy candy items should not be construed as ornamentation only. Chewy candy items of Applicant's Application should be given the broadest reasonable interpretation and in doing so refer to Applicant's specification for their interpretation.

Applicant's Application refers to "chewy candy items" as "soft licorice, soft raspberries, juicy fruits, and similar soft yet pierceable candies". Applicant's Application page 3, lines 23-24. Applicant choice of "chewy candy items" is not based upon its aesthetic appeal for ornamentation instead they are based off their durability and ability to stay upon the hook. In doing so the typical user of Applicant's invention, candy vendors, would be able to display and advertise those "chewy candy items" in which they want to.

THE REFERENCES AS CITED IN THE OFFICE ACTION FAILS TO DISCLOSE CLAIMED FEATURES OF APPLICANT'S APPLICATION OF CLAIM 8

Notwithstanding the Examiner's failure to comply with Federal Circuit precedent, *Westmoland* fails to disclose the claimed features, even under Examiner's construction of the claim terms. The first element of Claim 8 in Applicant's Application calls for an earring clip wherein one hook is secured onto the clip and a chewy candy item is secured to the hook. An automatic LED is additionally disposed on the clip for lighting the chewy candy item.

In *Westmoland*, even assuming that “chewy candy items” are chosen solely for their aesthetic appeal for ornamentation, Applicant’s “chewy candy items” are hung from the earring clip not from the lighting element as in *Westmoland*. In *Westmoland*, the pierced earring wire (10a) is attached to an lighting element (4a) whereby decorative elements (29) may be hung from. *Westmoland* Figure 8, Column 6 line 37 – Column 7 line 15. Applicant’s Application, as demonstrated in Figure 2, attaches an LED light (16) secured to an earring clip (10). The earring clip (10) additionally has hooks (12) and (15) wherein the chewy candy items are to be hung by. Applicant’s Application page 3 line 1 – line 10, Figure 2.

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application over the prior art of record. The undersigned attorney may be contacted at (713) 275-3400 with respect to any questions, comments, or suggestions in relation to this appeal.

Respectfully submitted,

Date: Nov 30, 1980



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CLAIMS APPENDIX

1. (Previously Amended) An advertising apparatus for produce vendors comprising:
 - a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one hook secured to said earring clip;
 - c. at least one edible food item removably secured to said hook, wherein said edible food item is selected from the group: a fruit, a vegetable, and combinations thereof; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item.
2. (Original) The advertising apparatus of claim 1, wherein at least one hook comprises at least two hooks connected in series.
3. (Cancelled)
4. (Previously Amended) The advertising apparatus of claim 1, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip.
5. (Original) The advertising apparatus of claim 1, wherein said hook is between 1.5 inches and 3 inches in overall length.
6. (Original) The advertising apparatus of claim 1, wherein said hook is adapted to have at least a first prong and a second prong for engaging at least two food items.
7. (Original) The advertising apparatus of claim 1, wherein the edible food item is selected from the group: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruits with similar sturdy yet pierce-able skins, and vegetables with similar sturdy yet pierce-able skins.
8. (Previously Amended) An advertising apparatus for candy vendors comprising:

- a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one hook secured to said earring clip;
 - c. at least one chewy candy item removably secured to the hook; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the chewy candy item.
9. (Original) The advertising apparatus of claim 8, wherein said candy is selected from the group: soft licorice, soft raspberries, juicy fruits, and like soft candies.
10. (Original) The advertising apparatus of claim 8, further comprising a line wherein said hook connects said line near said earring clip and a second hook connects to said line further from said earring clip than said hook.
11. (Cancelled)
12. (Previously Amended) The advertising apparatus of claim 8, wherein said LED light is a blinking light that can be actuated with a switch secured to said earring clip.
13. (Original) The advertising apparatus of claim 8, wherein said hook is between 1.5 inches and 3 inches in overall length.
14. (Original) The advertising apparatus of claim 8, wherein said hook is adapted to have at least two prongs for engaging at least two candies.

Evidence Appendix

None

Related Proceedings Appendix

None